



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/361,572	01/30/2012	Curtis P. Hamann	9300-CON	5974

53609 7590 05/03/2017
REINHART BOERNER VAN DEUREN P.C.
2215 PERRYGREEN WAY
ROCKFORD, IL 61107

EXAMINER

YAGER, JAMES C

ART UNIT	PAPER NUMBER
----------	--------------

1782

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

05/03/2017

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

RockMail@reinhardtllaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CURTISS P. HAMANN

Appeal 2016-002948
Application 13/361,572¹
Technology Center 1700

Before JEFFREY T. SMITH, DONNA M. PRAISS, and
AVELYN M. ROSS, *Administrative Patent Judges*.

PRAISS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ SmartHealth, Inc. is identified as the real party in interest. App. Br. 2.

² In this decision, we refer to the Specification filed Jan. 30, 2012 (“Spec.”), the Final Office Action dated Apr. 7, 2015 (“Final Act.”), the Appeal Brief filed Aug. 26, 2015 (“App. Br.”), the Examiner’s Answer dated Nov. 23, 2015 (“Ans.”), and the Reply Brief filed Jan. 20, 2016 (“Reply Br.”).

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's final decision to reject claims 1–6 as obvious under 35 U.S.C. § 103(a) over Vistins³ and Cooke.⁴ App. Br. 4; Final Act. 3.

We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The subject matter on appeal relates to elastomeric articles, particularly, “multicolored, multilayered elastomeric articles” including “gloves and other multilayer, dipped elastomeric articles, such as elastomer sheets, or condoms.” Spec. ¶¶ 1, 2. Claim 1, the sole independent claim, is illustrative and copied from the Claims Appendix (disputed matter italicized and paragraphing added):

1. A flexible, elastomeric glove having an outside surface and a wearer contacting surface, the glove comprising:

a first layer having an exposed surface bearing a first design and a second, unexposed surface;

a second layer having an exposed surface bearing a second design, and a second unexposed surface, the entire unexposed surface of the first layer being permanently bonded to the entire unexposed surface of the second layer; and

wherein the first design of the first layer is sufficiently visually distinct from the second design of the second layer permitting the human eye to distinguish between the first layer and the second layer of the multilayer article.

³ Vistins, US 2003/0124354 A1, published July 3, 2003 (“Vistins”).

⁴ Cooke, US 6,625,816 B1, issued Sept. 30, 2003 (“Cooke”).

OPINION

The Examiner finds that claims 1–6 would have been obvious to one of ordinary skill in the art at the time of the invention for the reasons stated on pages 2–5 of the Final Action.

Appellant argues that the Examiner erred because the stated reason to combine Cooke with Vistins is “unsupported by rational underpinnings” because “[t]here is simply no support in the art of record that camouflage with a logo is a design that is indicative of multiple layers or that such a design would assist a user having color blindness in determining that they are seeing multiple layers of a glove.” App. Br. 7. According to Appellant, Cooke’s “‘design’ of even more colors would not be helpful for one with color blindness.” *Id.* Appellant argues “because the secondary reference does not disclose, teach nor suggest any advantages whatsoever for a user to distinguish multiple layers, or for a color blind person to distinguish multiple layers, then the articulated reason for modifying the primary reference of Vistins with Cooke lacks rational underpinnings.” *Id.* Appellant further argues that “because the visibility of multiple colors when viewing Vistins’ top layer is an indicator that one of its layers has been breach[.],” modifying Vistins’ glove with Cooke’s camouflage would thwart the intended purpose of Vistins “because the user of the modified [Vistins] glove would believe its layers have been breached upon seeing the different colors of the camouflage.” *Id.* at 8.

The Examiner responds that “Cooke is merely used to teach that it is known to provide designs and patterns on a glove in addition to color.” Ans. 5. The Examiner finds that “Vistins already discloses a glove having layers with different colors in order to enable an observer to distinguish multiple

layers of the glove and offer reassurance that there are multiple layers of protection.” *Id.* (citing Vistins ¶¶ 50, 52). The Examiner further responds that “Appellant provides no evidence that a pattern would make it impossible for a user to determine if the outer layer of the glove has been breached.” *Id.* at 6.

In the Reply Brief, Appellant argues that because the Examiner finds that “Vistins already discloses gloves having layers with different colors in order to enable an observer to distinguish multiple layers of the glove and offer reassurance that there are multiple layers of protection[,]’ there is no problem to be solved.” Reply Br. 5 (emphasis omitted). Because the solution is already disclosed by Vistins, Appellant contends that “common sense dictates against further modification Vistins for the reasons cited by the Examiner.” *Id.* at 6. Appellant also asserts that the Examiner’s finding that Vistins would be improved by different patterns being used in addition to different colors “is not actually a rationale to combine references but is instead a statement of hindsight bias, evincing the nonobviousness of Applicant’s claims.” *Id.* at 7. Appellant additionally argues that modification of Vistins to include the camouflage pattern on the outer layer such as in Cooke, would “render Vistins unsatisfactory for its intended purpose” because a breach would not be recognized and that no evidence is necessary to support its position. *Id.* at 8–9.

Appellant’s arguments are unpersuasive of reversible error because, in this case, Vistins identifies the design need to solve a problem (visually distinctive layers in a glove) and Cooke evidences that it was known in the art to provide patterns on a glove in addition to color. “[W]hen there is a design need to solve a problem and there are a finite number of identified,

predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR*, 550 U.S. at 406. The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” 550 U.S. at 415, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* [*v. John Deere Co.*, 383 U.S. 1 (1966)] reaffirmed the ‘functional approach’ of *Hotchkiss* [*v. Greenwood*, 52 U.S. 248 (1850)],” *id.*, and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is

likely to be obvious when it does no more than yield predictable results.” *Id.*

The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate the application of this doctrine.” *Id.* at 416. “In *United States v. Adams* [383 U.S. 39 (1966)], . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* “*Sakraida* [*v. AG Pro, Inc.*, 425 U.S. 273 (1976)] and *Anderson’s-Black Rock* [*Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative — a court must ask whether the improvement is more than the predictable use of prior art elements according to their established function.” *Id.* at 417.

The Supreme Court stated that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 418. The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

Appellant does not dispute the Examiner’s finding that Vistins teaches the use of different colorations of the layers of a glove to “provide[] a visual contrast to enable an observer to distinguish multiple layers of the glove and offer[] the reassurance that there are multiple layers of protection.” Ans. 4 (citing Vistins ¶¶ 50, 52). Nor does Appellant dispute the Examiner’s finding that “Cooke discloses gloves comprising indicia including various designs such as logos, advertisement, geometrical designs or camouflage (i.e. design, pattern)” (*id.*, citing Cooke 2:48–3:5) evidencing “that designs and patterns are also known in the field of gloves” (*id.* at 5). Thus, there is no dispute as to the scope and content of the prior art. Regarding the second *Graham* factor, the only difference between the claimed subject matter and Vistins is the use of designs rather than colors to provide the visual contrast

to distinguish multiple layers in a glove. The operative question in this case is whether the substitution of Vistins' colored layers with a known design alternative (Cooke's graphic design, specifically camouflage, instead of color) is a predictable use according to their established functions of being visible.

Appellant essentially argues that the modification of Vistins would not be predictable because (1) Cooke does not also teach that its imprinted layer "would in any way enable a color blind person to distinguish multiple layers in order to feel more secure" (App. Br. 6) or "advantages . . . for a user to distinguish multiple layers" (*id.* at 7), and (2) Vistins would not operate as intended if its layers were modified with Cooke's camouflage design, which is said to "create a mosaic of colors", because visibility of multiple colors when viewing Vistins' top layer would indicate the layers have been breached (*id.* at 8 (quoting Cooke 3:60–65); Reply Br. 8–10). Appellant's arguments are not persuasive for a number of reasons.

First, the prior art teaching of distinguishing multiple layers based on the visual appearance of the layers is present in Vistins itself. Vistins ¶¶ 50–52. Second, Appellant has not adequately shown that Cooke's foliage camouflage pattern would not function as an indicator of a layer in a multilayer glove. According to Cooke, the "mosaic of colors" that Appellant quotes is the embodiment that "blends in with foliage." Cooke 3:64–65. Third, Appellant's argument is directed to a single embodiment of Cooke, rather than the broader teaching of Cooke. Cooke broadly teaches that its pattern "may vary with the intended use" (Cooke 4:15–16) and may be a solid color pattern (*id.* at 4:17–18). Therefore, we are not persuaded that modification of Vistins' multilayer glove by substituting the known

alternatively patterned glove layer evidenced by Cooke would make Vistins inoperable for its intended purpose or otherwise render the combination unpredictable.

We also are not persuaded that the Examiner's combination of Vistins and Cooke is based on improper hindsight as Appellant argues in the Reply Brief (Reply Br. 6–8). Combining known elements of the prior art often necessitates looking to multiple patents that are interrelated. *KSR*, 550 U.S. at 418. Both Vistins and Cooke relate to elastomeric gloves, and, specifically, the visual appearance of layer(s) of such gloves.

In addition, we are not persuaded by Appellant's argument that "common sense dictates against further modification [of] Vistins" because Vistins already discloses how to distinguish multiple layers of a glove, and, therefore, there is no problem to be solved (Reply Br. 5–6). The reason for declining to reverse the rejection of claimed subject matter that would have been obvious under § 103 is based on the proposition that issuing such claimed subject matter withdraws from the public domain subject matter that those skilled in the art should be free to use. *Graham*, 383 U.S. at 6 (patents whose effects are to remove existent knowledge from the public domain or to restrict free access to materials already available should not be issued). *See also In re Kubin*, 561 F.3d 1351, 1357–58 (Fed. Cir. 2009) (a patent on such a structure would remove from the public that which is in the public domain by virtue of its inclusion in, or obvious from, the prior art); *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1259 (Fed. Cir. 2007) (obvious variants of prior art references are themselves part of the public domain).

It may be true that Vistins and Cooke each solve different problems. However, those practicing the Vistins invention should be free to make a

modification to that invention by including in the Vistins multilayer glove the patterns described by Cooke. Allowance of claim 1 on appeal on the record before us would preclude those skilled in the art from practicing an obvious modified Vistins invention. As *KSR* notes, § 103 is designed to prevent that from happening.

Appellant does not separately argue the patentability of dependent claims 2–6. App. Br. 5–9. Therefore, these claims fall with independent claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

In sum, we affirm the Examiner’s rejection of claims 1–6 as obvious over Vistins in combination with Cooke.

CONCLUSION

We affirm the Examiner’s rejections of claims 1–6 as obvious under 35 U.S.C. § 103(a).

DECISION

The Examiner’s decision is affirmed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED